

Piziali, Andrew

From: Piziali, Andrew
Sent: Thursday, April 17, 2008 9:12 AM
To: Paris, Cassandra
Subject: Appeal Return 10/736,119

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Paris, Cassandra Delivered: 4/17/08 9:12 AM Read: 4/17/08 9:20 AM

Hello Cassandra,

The Examiner's Answer I wrote for application 10/736,119 was recently returned to me by you. The return sheet says "(8) in the answer 3,755,051 (STUMPF) is not mentioned in any rejection for the after final office action of 5/21/07. Please clarify." No directions were given how to respond, so I'm writing you this email.

The reference (USPN 3,755,051 to Stumpf) in question was listed under "Evidence Relied Upon" and was not mentioned in my final rejection. It was properly not mentioned in my rejection because it is not a rejection reference. It was properly listed under "Evidence Relied Upon" because it is evidence relied upon.

First, I properly cited Stumpf on a PTO-892 mailed on 7/12/2005 so this is not a "new" reference. Secondly, Stumpf is cited merely to rebut appellant's arguments as to what is well-known. The only time I mention Stumpf in my Examiner's Answer is the fifth paragraph under "Response to Argument" wherein it is clear that the reference is cited merely as evidence that it is well-known in the art that the depth of pile or degree of loft depends on the denier of the fibers. Thirdly, even if the reference was brand new (cited for the first time in the Examiner's Answer), which it is not, the MPEP even says an examiner is allowed to cite a new reference as evidence as to what is well known without constituting a new ground of rejection. But I'm not even doing something that severe because I cited Stumpf on 7/12/2005 and also in my final rejection argument section.

http://www.uspto.gov/web/offices/pac/mpep/documents/1200_1207_03.htm

"Where a newly cited reference is added merely as evidence of the prior art statement made by the examiner >as to what is "well-known" in the art which was challenged for the first time in the appeal brief, the citation of the reference in the examiner's answer would not >ordinarily< constitute a new ground of rejection within the meaning of 37 CFR *> 41.39(a)(2)."

Therefore, I followed proper procedure and the case should be sent to the BPAI for decision.

-Andrew

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